



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,824	01/05/2004	Wolfgang Ebenbeck	CH-7990/LeA 36,508	3612
34947	7590	02/02/2005	EXAMINER	
LANXESS CORPORATION PATENT DEPARTMENT/ BLDG 14 100 BAYER ROAD PITTSBURGH, PA 15205-9741			DAVIS, BRIAN J	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,824

Applicant(s)

EBENBECK ET AL.

Examiner

Brian J. Davis

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 11-17 is/are rejected.
- 7) ☒ Claim(s) 1-10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/26/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

Claims 1-10 are objected to because of the following informalities: The claim text uses non-standard English grammar. The examiner respectfully suggests that the indefinite article "A" should be inserted as the first word in each claim. Appropriate correction is required.

Claim 6 is additionally objected to because of the following informalities: the claim does not end with a period. Claims must begin with a capital letter and end with a period. MPEP 608.01(m). Appropriate correction is required.

Claim 9 is additionally objected to because of the following informalities: the claim text uses non-standard English grammar. The examiner respectfully suggests that the verb "comprising," or an equivalent phrase, should appear in the first line of the claim after the introductory clause, something along the lines of: "A Process according to claim 1 further *comprising*...". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-17 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The only "step" in the above process claims is the "step"

Art Unit: 1621

of providing a compound of claim 1. It is also unclear in the above claims to what sets of compounds (aside from those of claim 1) applicant wishes to refer. Compounds are broadly described as "fluorine compounds," "hydroxyl compounds," etc., or by their end use: "agrochemicals, drugs and liquid crystals." With such definitions, the metes and bounds of the claim are unclear and would require an undue level of experimentation to determine if a particular compound falls within applicant's definitions and could be synthesized starting from the compounds of formula (I) of claim 1. Case law seems clear on this point: The specification must teach how to make and use the invention, not teach how to figure out for oneself how to make and use the invention. *In re Gardner*, 166 USPQ 138 (CCPA 1970).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 7-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 3,092,637, cited by the applicant in the IDS.

The reference teaches applicant's process, for example, the reaction of N,N-dimethylformamide and carbonyl fluoride (difluorophosgene) under autogenous pressure at 25°C to yield the corresponding gem-difluoro compound 1,1-difluorotrimethylamine (1,1-difluoromethyl-N,N-dimethylamine) (column 3 line 6,

Art Unit: 1621

example 1; see also examples IV and VIII). Claim 2 has been included in this rejection as the use of a solvent (or not) is considered to be a mere engineering expediency – absent some showing of criticality. Solvents are ubiquitous in reaction chemistry and the choice of any one solvent, or a set thereof, for use in a particular reaction is well within the purview of the ordinary practitioner.

Claims 1-5 and 7-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Journal of the American Chemical Society* (1962), Vol. 84, No. 22, p. 4275-4285, cited by the applicant in the IDS.

The reference teaches applicant's process, for example, the reaction of N,N-dimethylformamide and carbonyl fluoride (difluorophosgene) at 25°C to yield the corresponding gem-difluoro compound 1,1-difluorotrimethylamine (page 4276 Table I entry no. 3). Claim 2, as above, has been included in this rejection as the use of a solvent (or not) is considered to be a mere engineering expediency – absent some showing of criticality.

Claims 1-5 and 7-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Zeitschrift fuer Anorganische und Allgemeine Chemie* (1986), 537, p. 63-78, cited by the applicant in the IDS.

The reference teaches applicant's process, for example, the reaction of N,N-dimethylformamide and difluorophosgene at room temperature to yield the corresponding gem-difluoro compound 1,1-difluorotrimethylamine (page 64 reaction (2))

Art Unit: 1621

compound VI [see also compounds IX, X and XI]; page 77 Experimentelles). Claim 2, as above, has been included in this rejection as the use of a solvent (or not) is considered to be a mere engineering expediency – absent some showing of criticality.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: *Journal of Organic Chemistry* (1976), Vol. 41, No. 20, p. 3253-3255 and *Zeitschrift fuer Anorganische und Allgemeine Chemie* (1981), 474, p. 7-17 (CASREACT abstract) are cited to show related reactions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

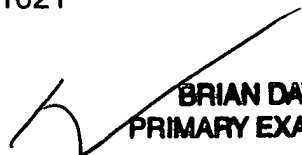
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/751,824

Page 6

Art Unit: 1621

 **BRIAN DAVIS**
PRIMARY EXAMINER

Brian J. Davis
January 31, 2005